

Applicant: Steenkamer, et al
Application No.: 10/521,893
Response to Election Requirement Dated December 21, 2006
Response Dated January 22, 2007
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Remarks/Arguments:

REMARKS

The application is subject to an election requirement, as follows:

Species A: Species shown in Figure 4; and

Species B: Species shown in Figures 7 and 8.

Applicants provisionally elect Species B with traverse. It is respectfully submitted that claims 1, 2 and 13-20 read on Species B as defined by the examiner.

The examiner alleges that:

The structural requirement for each of the species a and b is distinct from the other and species a and b are mutually exclusive. Therefore, species a and b lack the same or corresponding special technical features and are not directed to a single general inventive concept as required. (Action dated December 21, 2006, page 3)

Applicants respectfully traverse.

Applicants respectfully submit that the claims of the subject application relate to only one invention, as defined by independent claim 1. Independent claim 1 is generic, and Species A and B have a technical relationship, which finds expression in claim 1.

The technical feature of claim 1, *inter alia*, that particularly define a contribution over the prior art is the travel-limiting means. The travel-limiting means are designed in such a manner that a squeegee edge can only move over a relatively short distance from the working position in the direction away from the squeegee holder.

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In Species A, the travel-limiting means are defined by, *inter alia*, the stop 20 and the stop limiter 19. In Species B, the travel-limiting means are defined, *inter alia*, by the squeegee blade 114 and the projection 128. Thus, both Species A and Species B have the same special technical feature of the traveling-limiting means. Therefore, both species, as defined by the examiner, are directed to a single general inventive concept. Thus, unity of invention is present, and the requirement for an election of a species should be withdrawn.

Moreover, it is respectfully submitted that the claims of the subject application have only one independent claim. Therefore, dependent claims 2-20 have by definition the same or corresponding special technical features. Thus, the claims of the subject application satisfy the condition for unity of invention as required under PCT 13.2.

For convenience of the examiner certain PCT Rules and Guidelines are reproduced below, as follows:

PCT Rule 13.1 Requirement

The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention").

PCT Rule 13.2 Circumstances in Which the Requirement of Unity of Invention Is to Be Considered Fulfilled

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the

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claimed inventions, considered as a whole, makes over the prior art.

Guidelines: AI Annex B, Part 1(c)

10.06 Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims. (emphasis added)

10.07 If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention. (emphasis added)

These Rules and Guidelines clearly state that claims 1-20 of the subject application have unity of invention because, *inter alia*, there is only one independent claim. Further, the examiner has not offered any arguments concerning the limitations of claim 1 with respect to any prior art. Without presenting any arguments regarding the prior art and the limitations of claim 1, the examiner has clearly failed to present a *prima facie* case for an alleged lack of unity of invention.

Thus, reconsideration and withdrawal of the requirement for an election of a species is respectfully requested.

Moreover, during the international phase of the subject application, the claims were ruled in compliance with the unity of invention requirements as set forth in PCT Rule 13. See, e.g., the international PCT search report. According to PCT Article 27(1), it is not allowed for any national law to require compliance with requirements relating to the contents of the international application different from or additional to those provided for in the PCT. Thus, the unity of invention requirement laid down in PCT Rule 13 must be accepted by all the designated and elected offices, including the United States Patent and Trademark Office, as set forth below:

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PCT Article 27(1) National Requirement

No national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations.

PCT Applicant's Guide (Articles 2(x) & 27(1) & Rule 13

138. An international application which complies with the unity of invention requirements laid down in Rule 13 must be accepted by all the designated and elected Offices, since Article 27(1) does not allow any national law (as defined in Article 2(x)) to require compliance with requirements relating to the contents of the international application different from or additional to those provided for in the PCT. (emphasis added)

Moreover, the PCT Administrative Instructions which further detail the governing procedures for PCT Rules 13.1 and 13.2, also specifically caution examiners that determination of unity of invention must be carefully made with logically presented, technical reasoning. In particular and especially in the case of *a posteriori* determinations, any finding of lack of unity of invention must only be made after meeting a high burden of proof, as follows:

[E]specially in an “*a posteriori*” situation ... stating the finding of lack of unity of invention ... should only be made, however, where the lack of unity is beyond doubt. (PCT International Search Guidelines, PCT Gazette - Section IV, S-06/1998(E), page 27, 8 October 1998) (emphasis added)

Further, the PCT Administrative Guidelines further state the benefit of any doubt relating to unity of invention should be given to the applicant, as follows:

Although lack of unity of invention should certainly be raised in clear cases, it should neither be raised nor persisted in on the basis of a narrow, literal or academic approach. ... [T]he benefit of any doubt being given to the applicant. (PCT

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International Preliminary Examination Guidelines, PCT Gazette -
Section IV, S-07/1998(E), page 23, 29 October 1998) (emphasis
added)

In view of the above-described standards, guidelines, rules and articles for determination of unity of invention and in further view of the arguments presented above, the Action clearly fails to present a *prima facie* showing of lack of unity of invention. Therefore, Applicants respectfully request withdrawal of the requirement for restriction and that prosecution of the application, including all of claims 1-20, proceed on the merits.

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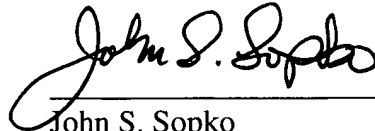
Summary

Therefore, Applicants respectfully submit that claims 1-20 are in condition for examination on the merits. Favorable action thereon is therefore respectfully solicited.

Should the Examiner have any questions or comments concerning the above, the Examiner is respectfully invited to contact the undersigned attorney at the telephone number given below.

No additional claim fee is believed to be due with this submission. If a claim fee is due, the Commissioner is hereby authorized to charge payment of any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 08-2461. Such authorization includes authorization to charge fees for extensions of time, if any, under 37 C.F.R. § 1.17 and also should be treated as a constructive petition for an extension of time in this reply or any future reply pursuant to 37 C.F.R. § 1.136.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "John S. Sopko", is written over a horizontal line.

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